

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action dated April 8, 2008 ("*Office Action*"). In the Office Action, Claims 1-3, 5-8, 10, 11, 13-30, 32, 33, and 35-38 are pending; and Claims 1-3, 5-8, 10, 11, 13-30, 32, 33, and 35-37 rejected. Applicants amend Claims 2, 3, 5, 6, 7, 15, 18, 22, 26, 30, 32, 35, 37, and 38. Applicants cancel Claim 1. Applicants respectfully request reconsideration and favorable action in this case.

### **Allowable Subject Matter**

Applicants note with appreciation the Examiner's indication that Claim 38 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Applicants have amended independent Claim 38 to incorporate limitations of Claim 1, which is now cancelled without prejudice or disclaimer. Claims 2-3 and 5-6 have been amended to depend from allowable Claim 38 rather than Claim 1. Therefore, independent Claim 38, together with Claims 2-3 and 5-6 that depend from Claim 38, should now be in condition for allowance.

### **Interview Summary**

Applicants thank the Examiner for conducting the telephone interview on July 2, 2008, and for the thoughtful consideration of this case. During the telephone interview, Applicants and Examiner discussed the rejection of Claims 26 and 32 under 35 U.S.C. § 101 and possible amendments to the claims to overcome these rejections. It is Applicants' understanding that the Examiner agrees that the claims as presented in this Response Applicants recite statutory subject matter under 35 U.S.C. § 101.

### **Section 101 Rejections**

The Office Action rejects Claims 26-29 and 32-33 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner states that "Claims 26-29 and 32-33 are directed to a computer program" and "are neither computer components nor statutory processes, as they are not "acts" being performed." (*Office Action*, pages 2-3). During a telephone interview on July 2, 2008, Applicants and Examiner discussed possible amendments to the claims to overcome these rejections. Per the Examiner's suggestion, Applicants have amended Claim 26 to recite a "computer readable medium encoded

with logic capable of being executed by a processor” to perform the recited steps. Likewise, Applicants have amended Claim 32 to recite a “computer readable medium encoded with logic capable of being executed by a processor” to perform the recited steps. It is Applicants’ understanding that the Examiner agrees that the claims as presented in this Response Applicants recite statutory subject matter under 35 U.S.C. § 101.

For at least these reasons, Applicants respectfully request that the rejection of Claims 26-29 and 32-33 under 35 U.S.C. § 101 be withdrawn.

### **Section 103 Rejections**

The Office Action rejects Claims 1-3, 5-8, 10-29, 30, 32-33 and 35-37 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of U.S. Patent No. 5,799,273 issued to Mitchell et al. (“*Mitchell*”), U.S. Patent No. 6,240,391 issued to Ball et al. (“*Ball*”), U.S. Patent No. 6,068,487 issued to Dionne (“*Dionne*”), and U.S. Patent No. 6,424,357 issued to Frulla et al. (“*Frulla*”). For the reasons described below, Applicants respectfully request reconsideration and allowance of Claims 1-3, 5-8, 10-29, 30, 32-33 and 35-37.

#### **A. The Claims are Allowable over the Proposed Combinations**

First, Applicants respectfully submit that the proposed combinations of references do not disclose, teach, or suggest the elements recited in Applicants’ claims.

##### **1. Claims 2-3, 5-6**

As stated above, the Examiner has identified Claim 38 as including allowable subject matter. To advance this case to issuance, Applicants have rewritten Claim 38 in independent form. Thus, Claim 38 has been amended to incorporate the limitations formerly recited in Claim 1, which is now cancelled without prejudice or disclaimer. Claims 2-3 and 5-6 have been amended to depend from allowable Claim 38 rather than Claim 1.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 2-3 and 5-6.

**2. Claims 7-8, 10-11, 13-30, 32-33, and 35-37**

Without conceding the veracity of the rejections over the cited art and solely to advance this case to issuance, Applicants have amended independent Claims 7, 10, 15, 18, 22, 26, 30, 32, 35, and 37. For example, Applicants have amended Claim 7 to recite “removing the electronic markers from the audio file during playback” and “tracking the number of words played by counting the number of electronic markers removed.” As another example, Claim 10 has been amended to recite “removing the electronic markers from the audio file during playback” and “tracking the number of words played by counting the number of electronic markers removed.” Independent Claims 15, 18, 22, 26, 30, 32, 35, and 37 have similarly been amended to recite certain analogous features and operations. Thus, independent Claims 7, 10, 15, 18, 22, 26, 30, 32, 35, and 37 recite certain features and operations similar to those identified by the Examiner to be allowable over the prior art of record with regard to Claim 38. Accordingly, Applicants respectfully submit that independent Claims 7, 10, 15, 18, 22, 26, 30, 32, 35, and 37 are allowable over the cited references for the same reasons that Claim 38 is allowable.


For at least these reasons, Applicants request reconsideration and allowance of independent Claims 7, 10, 15, 18, 22, 26, 30, 32, 35, and 37, together their respective dependent claims (including Claims 8, 11, 13-14, 16-17, 19-21, 23-25, 27-29, 32-33, and 36).

**CONCLUSION**

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 953-6809.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
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